

40. The method as claimed in claim 37, wherein said thermoplastic elastomer comprises elastificated polyolefin, styrene block copolymer, copolyester elastomer, thermoplastic polyurethane, or a suitable mixture thereof. *butyl*

41. The method as claimed in claim 37, wherein said castable polyurethane system comprises a two-component or multi-component polyurethane system. --

### REMARKS

The applicant respectfully requests reconsideration in view of the amendment and following remarks. The applicants have cancelled claims 19-29 and rewritten them as claims 31-41. The applicants have rewritten the claims to overcome the 35 U.S.C. § 112, second paragraph rejection and the claim informality. In particular, the applicants have deleted the word "the" in line 1 of claim 19 (see claim 31). With respect to claim 24, the applicants have added the phrase "one or more" as suggested by the Examiner (see claim 36). Claims 30-41 are now in the application.

**The applicants respectfully request that claim 30 be rejoined upon determining the remaining claims are allowable. However, if the Examiner disagrees, the applicants authorize the cancellation of the non-elected claim 30.**

Claims 19-29 were rejected under 35 U.S.C. § 112, second paragraph. Claims 19-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Arlid *et al.* U.S. Patent No. 3,898,929 ("Arlid") in view of Meltz U.S. Patent No. 3,345,942 ("Meltz"). The applicant respectfully traverses these rejections.

**Section 112 Rejection**

Claims 19-29 were rejected under 35 U.S.C. § 112, second paragraph. The applicant has amended claim 19 by providing proper antecedent basis for the term "the roller." The applicant believes that the claims as amended are in compliance with 35 U.S.C. § 112, second paragraph. For the above reasons, this rejection should be withdrawn.

**Section 103 Rejection**

Claims 19-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Arlid in view of Meltz. Arlid discloses a hickey picking cylinder 10 comprising a steel roller core 11 and a roller covering 12 of a rubber latex composition. This is not running in a dampening system but in the ink train of a printing press (abstract; fig. 3; col. 3, lines 7-10 and 33-39). The only place that the dampening system is mentioned is at col. 4, lines 3-10 which Arlid states:

The press is also provided with a dampening system and the fountain solution is transferred from the tray 33 to the coated roller 34 by a roller 35 which is immersed in the solution. The ductor roller 36 oscillates between the two coated rollers 34 and 37 and roller 37 supplies the dampening solution to the hard surfaced rollers 38 and 39 which are in contact with the plate cylinder 19.

The coated rollers 34 and 37 mentioned in connection with the dampening system, however, are not further described. There is no teaching of the applicants' claimed method, let alone the applicants' claimed cover for the dampening roller.

The roller disclosed by Meltz has a covering comprising rubber having polytetrafluoroethylene particles dispersed therein used in an inking system (col. 5, lines 9-11; claim 5). The teachings of Arlid and Meltz neither alone nor in combination render the claimed invention (comprising the step of running an elastomer or elastic plastic covered roller in a dampening system) obvious. This teaching, however, is totally contrary to the observation

underlying applicants' invention. Applicants surprisingly discovered that on the surface of a roller comprising a covering composed of an elastomer material or elastic plastic material containing fluorinated polyolefin which is run in the dampening system of an offset printing machine the ink deposit on the surface of such roller covering is even less than on a roller covering which does not contain the fluorinated polyolefin.

The Examiner must consider the references as a whole, In re Yates, 211 USPQ 1149 (CCPA 1981). The Examiner cannot selectively pick and choose from the disclosed multitude of parameters without any direction as to the particular one selection of the reference without proper motivation. The mere fact that the prior art may be modified to reflect features of the claimed invention does not make modification, and hence claimed invention, obvious unless desirability of such modification is suggested by the prior art (In re Baird, 29 USPQ 2d 1550 (CAFC 1994) and In re Fritch, 23 USPQ 2nd. 1780 (Fed. Cir. 1992)). The applicants disagree with the Examiner why one skilled in the art with the knowledge of the references would selectively modify the references in order to arrive at the applicants' claimed invention. The Examiner's argument is clearly based on hindsight reconstruction.

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching, suggestion, or incentive supporting this combination, although it may have been obvious to try various combinations of teachings of the prior art references to achieve the applicant's claimed invention, such evidence does not establish prima facie case of obviousness (In re Geiger, 2 USPQ 2d. 1276 (Fed. Cir. 1987)). There would be no reason for one skilled in the art to combine Arlid with Meltz. For the above reasons, this rejection should be withdrawn.

Assuming *arguendo* that the Examiner has made a *prima facie* case of obviousness, the applicants have shown unexpected results in the specification in which the applicants produce identical examples with the exception of having the fluorinated polyolefin and a non-fluorinated polymer (see Example 1 and the comparison at page 7 of the specification). As noted, with the comparison, the roller had to be cleaned three times while the same roller without the fluorinated polymer and with the fluorinated polymer the roller did not have to be cleaned at all. As discussed in the specification at page 3, lines 19-24, the object was to lengthen the cleaning intervals, especially of the dampening rollers while the high quality of the dampening process itself is retained and to reduce the cleaning costs considerably that way. Surprisingly, this object has been accomplished by adding fluorinated polyolefins to the roller covering. For the above reasons, the applicant respectfully requests that this rejection be withdrawn.

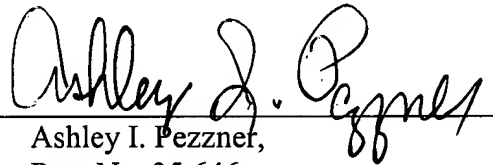
No additional fees are due. If there are any additional fees due in connection with the filing of this response, including any fees required for an additional extension of time under 37 CFR 1.136, such an extension is requested and the Commissioner is authorized to charge or credit any overpayment to Deposit Account No. 03-2775.

For the reasons set forth above, Applicants believe that the claims are patentable over the references cited and applied by the Examiner and a prompt and favorable action is solicited.

The applicants believe that these claims are in condition for allowance, however, if the Examiner disagrees, the applicants respectfully request that the Examiner telephone the undersigned at (302) 888-6270.

Respectfully submitted,

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